

## **REMARKS / DISCUSSION OF ISSUES**

Claims 1-14, 16-17 and 20-21 are pending in the application.

### **Objection to the Drawings**

Applicants submit herewith a Replacement Sheet of Drawings for sheet 5/6 and including changes to Figs. 5D and 5E. In particular, a lead line to reference character 19-1 is amended to be consistent with Fig. 6 for example. No new matter is added.

As a result of the amendments to the drawings, Applicants submit that the objections are moot and should be withdrawn.

### **Finality of the Rejection is Improper**

Applicants gratefully acknowledge receipt of the English language translation of the ‘Detailed Description’ of ‘Toyota Corporation’ as referenced by the Examiner (Abstract of JP 2002313572 as previously applied). Applicants have considered the disclosure of the translation provided and address this below. This notwithstanding, Applicants respectfully submit that the present Office Action cannot have been made properly final.

As noted previously, MPEP § 706.02 spells out with clarity and specificity the requirements and rationale behind the need for consideration of a translated underlying document of an English-language abstract. *Ex parte Jones* cited in the MPEP and *Ex parte Shade* (Appeal No. 2001-1241)<sup>1</sup>, which cites *Jones*, makes it perfectly clear that reliance on an Abstract in lieu of the translated underlying document is not proper. Thus, reliance upon the Abstract alone at the first Office Action was improper and in essence deprived Applicants of the ability to consider the full underlying document translated into English. Because Applicants believe that reliance upon the foreign language abstract and not a translation of the underlying document in the first Office Action was improper, it is

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<sup>1</sup> Like *Jones*, *Shade* is unpublished. Yet, the Board buttresses the position of *Jones*, stating: “In the future, the examiner would be well-advised not to rely on foreign-language documents. An English-language equivalent, if available, or a translation of the foreign document would be a much more reliable basis for a prior art rejection. . . .”

improper for the Examiner to make the present rejection final. Moreover, it appears that a translation of the complete underlying document is not provided, but rather only the Detailed Description. A translation of the entire document is respectfully requested.

The Examiner implies that the onus is on the Applicants to obtain a translation of the underlying document because Applicants filed the Abstract in an IDS. There is no basis in the MPEP, Rules, Board decisions or case law provided by the Examiner or known to the undersigned to support this position. The Examiner directs Applicants to MPEP § 706.02, alleging that this places the onus on the Examiner to obtain a translation only in instances where the Examiner has cited the Abstract. The Examiner indicates that MPEP § 706.02 is related to “[p]rior art uncovered in searching the claimed subject matter...” Applicants point out the MPEP § 706.02 is entitled “Rejection on Prior Art” and provides procedures related thereto including the issue under present consideration. Moreover, the portion relating to proper procedure as it relates to translations of applied art is in the context of the ‘best evidence’ and states:

“Prior art uncovered in searching the claimed subject matter of a patent application often includes English language abstracts of underlying documents, such as technical literature or foreign patent documents which may not be in the English language.”

Nowhere in this portion of the MPEP or elsewhere in MPEP § 706.02 is there any description indicating that proper procedure mandates that only if the Examiner cites an English-language abstract must the Examiner obtain the translated underlying document. Rather, MPEP § 706.02 makes it clear that if the Examiner chooses to rely on an English language abstract, a translation of the underlying document must be relied upon instead.

Thus, and for at least the reasons set forth above, Applicants respectfully submit that the rejection is improperly made final and should be withdrawn. Moreover, and as noted above, it appears that only the ‘Detailed Description’ of the underlying reference has been supplied, and thus the full translation is lacking. This too supports Applicants’ position that the rejection is not properly made final.

## **Objections to the Claims and Rejections under 35 U.S.C. § 112, ¶ 2**

The objections to claims 6, 16, 17, 18 and 19 and rejections of claims 18 and 19 for indefiniteness have been addressed via amendment. Notably, improper multiple dependency have been deleted; and claims 18 and 19 are cancelled. The issues presented in this rejection do not exist in new claims 20 and 21, which encompass the subject matter of claim 15 in independent form.

## **Rejections under 35 U.S.C. § 102**

Claims 1, 6-9, 16 and 17 are rejected under 35 U.S.C. § 102(b) as being allegedly unpatentable over Toyota Corp. (JP 2002313572 A). For at least the reasons set forth herein, Applicants respectfully submit that a *prima facie* case of anticipation has not been established.

A proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

### **i. Claim 1**

Claim 1 recites:

*An electroluminescent device comprising a substrate, a light emissive structure on the substrate, the light emissive structure comprising organic light emissive material disposed between **first and second electrode layers** for supplying charge carriers into the organic material to cause it to emit light, the first and second electrode layers respectively underlying and overlying the organic light emissive material, and an **electrically conductive region underlying the light emissive structure on the substrate, the second electrode layer and the electrically conductive region being in electrical connection through the thickness of the organic light emissive material.***

The Office Action directs Applicants to the organic electroluminescence film 32a for the organic light emissive material; anode 31a and negative pole 33a for the first and second electrodes; and to anode 31b for the alleged disclosure of the electrically conductive region underlying the light emissive structure. The Office Action then directs Applicants to the anode 32b for the same underlying conductive region allegedly taught by the anode 31b. Finally, the Office Action asserts that the anode **32b** and the negative pole **33a** are in electrical connection through layer **31a**.

At the outset, it is noted that anode 32b and negative pole 33a are from separate devices that are isolated by septa 41, 42. Moreover, there is no disclosure of the anode of one device's being electrically connected to the negative pole of another (nor is this claimed in claim 1); so there is no disclosure of the connection of anode 32b to pole 33a, nor would there be at least because there is no organic electroluminescence material therebetween. In addition, the reference discloses anodes and cathodes of individual devices with a layer of organic electroluminescence material between. However, there is no electrically conductive region underlying the light emissive structure in addition to electrodes. Thus, and for at least the reasons set forth above, Applicants respectfully submit that the applied art fails to disclose at least one feature of claim 1.

ii. Claim 9

Claim 9 recites:

*A method of fabricating an electroluminescent device comprising fabricating a light emissive structure on a substrate, the **light emissive structure comprising organic light emissive material disposed between first and second electrode layers** for supplying charge carriers into the organic material to cause it to emit light, the first and second electrode layers respectively underlying and overlying the organic light emissive material, and an electrically conductive region underlying the light emissive structure on the substrate, and forming an electrical connection between the second electrode layer and the electrically conductive region through the thickness of the organic light emissive material.*

The rejection of claim 9 is essentially the same as the rejection of claim 1, which is improper for at least the reasons set forth above. Therefore, Applicants respectfully submit that the applied art fails to disclose at least one feature of claim 9 for at least the reasons set forth above.

Because the applied art fails to disclose at least one feature of each of claims 1 and 9 a prima facie case of anticipation has not be established based thereon. Thus, claims 1 and 9 are patentable over the applied art. In addition, claims 2-8 and 10-14, 16, 17, which depend from claims 1 and 9, respectively, are patentable for at least the same reasons and in view of their additionally recited subject matter.

### **Rejections under 35 U.S.C. § 103**

The rejections of claims 2,4,5 and 14 have been considered. While in no way conceding the propriety of these rejections, at least because claims 2,4,5 and 14 depend from one of claims 1 or 9, these claims are patentable for at least the same reasons and in view of their additionally recited subject matter.

### **Conclusion**

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:  
Phillips Electronics North America Corp.

/s/William S. Francos/

by: William S. Francos (Reg. No. 38,456)

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